

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

JUN 27 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD FERNANDES

Appeal No. 2005-0473
Application No. 09/514,946¹

ON BRIEF

Before DIXON, SAADAT and NAPPI, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1, 3-10, and 22-25. Claims 2 and 11-21 have been canceled.

We reverse.

BACKGROUND

Appellant's invention is directed to presenting a tailored promotion to a customer over a distributed communication network based on the activity information related to the already visited

¹ Application for patent filed February 28, 2000.

web sites upon the customer's visit to subsequent web sites. An understanding of the invention can be derived from a reading of exemplary independent claim 1, which is reproduced as follows:

1. A computer-implemented electronic commerce apparatus for generating a tailored promotion of goods and/or services offered by a subscriber to said apparatus based on personal consumer preferences for presentation by said subscriber to a consumer over a distributed communication network, comprising:

a connection to said distributed communication network;

a database of goods and/or service promotion data pertaining to goods and/or services offered by subscribers to said apparatus; and

a consumer information storage, said consumer information storage including a consumer identifier storage for storing consumer identifier information identifying individual consumers, and including for each stored consumer identifier activity information pertaining to network sites accessed by said individual consumers and associated with individual consumers;

wherein said electronic commerce apparatus receives said activity information, stores said activity information in said consumer information storage by individual consumer, receives from a particular subscriber network site consumer identifier information associated with a consumer requesting access to that subscriber network site, uses said stored activity information in conjunction with said goods and/or services promotion data in said database to create a tailored promotion of goods and/or services offered by said particular subscriber network site in response to said received consumer identifier information, and transmits said tailored promotion to said particular subscriber network site for presentation to said consumer.

Appeal No. 2005-0473
Application No. 09/514,946

The Examiner relies on the following references in rejecting the claims:

U.S. Patents

Gardenswartz et al. (Gardenswartz)	6,055,573	Apr. 25, 2000
		(filed Jan. 7, 1999)
Roth et al. (Roth)	6,285,987	Sep. 4, 2001
		(filed Jan. 22, 1997)

Published U.S. Patent Application

Travis et al. (Travis)	US 2002/0010668 A1	Jan. 24, 2002
		(filed Jan. 27, 2000)

Claims 1, 3-10, and 22-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gardenswartz and Roth.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gardenswartz and Travis.

We make reference to the answer (Paper No. 18, mailed May 6, 2004) for the Examiner's reasoning and to the appeal brief (Paper No. 17, filed February 17, 2004) and the reply brief (Paper No. 19, filed July 6, 2004) for Appellant's arguments thereagainst.

OPINION

With respect to the 35 U.S.C. § 103 rejection of the claims over Gardenswartz and Roth, we note that the Examiner relies on Gardenswartz for teaching that cookies are used to record the online activities of a consumer while the stored preferences may be interpreted as the sites visited (answer, page 4). The

Examiner further relies on Roth for teaching targeting ads by tracking user's visits to specific web sites (col. 1, lines 30-38) where the characteristics of the subscribing site is displayed to the user depending on the customer visiting (col. 2, lines 20-42) (id.).

Appellant argues that the Gardenswartz sends targeted advertisement to the consumers' computers based on the consumers' offline purchase histories that are sent to a database (brief, page 6; reply brief, page 3). Appellant further asserts that Gardenswartz mentions use of online activity only in the background of the invention and identifies such activity for providing tailored promotions as disadvantageous (brief, page 7; reply brief, pages 4 & 5). Additionally, Appellant points out that the proposed combination of Gardenswartz and Roth lacks proper motivation and would not have resulted in the claimed structure as no technical principle to tie the two references is presented (id.).

In response to Appellant's arguments, the Examiner merely asserts that relying on the disclosed background is proper and would provide the required suggestion regardless of other teachings in Gardenswartz (answer, page 7). The Examiner further argues that the participating web site that displays the targeted

advertising is taken as the subscriber which subscribes to and receives the services of the central server (id.).

As a general proposition, in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. See also In re Rouffet, 149 F.3d 1350, 1355, 47

USPQ2d 1453, 1456 (Fed. Cir. 1998). Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984).

We observe that claim 1 includes limitations related to the use of consumer identifier information associated with a consumer requesting access to a subscriber network site for transmitting tailored promotions to the particular subscriber network site for presentation to the consumer. Therefore, the consumer identifier information based on the consumer's online activities are used in conjunction with the goods and services promotion data to create the tailored promotion of goods and services offered by that particular subscriber network site.

Gardenswartz, in the background of the invention section, describes a method of targeted advertising over the Internet using "cookies" that track a consumer's online activity (col. 1, lines 11-19). Once the consumer attempts to access an advertiser's web site, the advertiser generates banner ads visible to the consumer when that site is visited (col. 1, lines 37-42). Although Gardenswartz disclosed invention takes advantage of the consumer's offline purchases for targeted advertising, as stated by the Examiner, the information in the

background section in itself teaches the use of cookies for extracting consumer information.

Roth on the other hand, based on the tracked information related to the sites a viewer has visited, provides a bidding opportunity for various advertisers according to a set criteria. The highest bid from those with matching specifications is selected and the advertisement specified therein is displayed (col. 2, lines 54-60).

Therefore, we agree with Appellant that, even based on the background section and contrary to the Examiner's assertion (answer, page 5), it is not clear how the cookies in Gardenswartz uses the consumer identifier information in conjunction with the promotion data to send the claimed targeted ad to a subscriber web site for presentation to the customer. Furthermore, we do not find any specific arguments presented by the Examiner to address the points of contention raised by Appellant as to how Roth would have provided the missing features or to point to any teaching in the references that would provide a suggestion for combining Gardenswartz and Roth.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the examiner's decision on appeal, the Board must

necessarily weigh all of the evidence and argument." In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In this case, taking the web site that displays an ad as a "subscriber" and taking displaying an ad for goods as the goods offered by a subscriber (answer, page 5), as discussed by Appellant (reply brief, pages 5 & 6), would result in improper construction of the claimed language.

Rejections based on § 103 must also rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). In concluding that the bidding for the advertisement displayed to a user in Roth is even relevant to Gardenswartz's tracked activities using cookies, without providing any reasonable factual evidence, the Examiner attempts to forge a combination of entirely different advertising approaches.

In view of our analysis above, we find that the Examiner has failed to set forth a prima facie case of obviousness because the

Appeal No. 2005-0473
Application No. 09/514,946

necessary teachings and suggestions related to the claimed creating a tailored promotion of goods and/or services offered by the subscriber network site in response to a consumer identifier information, as recited in independent claims 1 and 22 are not shown. Accordingly, based on the weight of the evidence and the arguments presented by the Examiner and Appellant, we are constrained to reverse the Examiner's decision and not sustain the 35 U.S.C. § 103 rejection of claims 1, 3-10, and 22-25.

We note that the Examiner, in rejecting claim 8, in alternative, relies on the combination of Gardenswartz and Travis which neither includes any teaching that reads on the disputed claimed features nor provides any suggestion for storing and using products and goods reviewed information in conjunction with the goods and services promotion data by a server. Accordingly, we do not sustain the alternate 35 U.S.C. § 103 rejection of claim 8.

Appeal No. 2005-0473
Application No. 09/514,946

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1, 3-10, and 22-25 under 35 U.S.C. § 103 is reversed.

REVERSED



JOSEPH L. DIXON)
Administrative Patent Judge)
)


MAHSHID D. SAADAT) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
)
ROBERT E. NAPPI)
Administrative Patent Judge)

MDS/ki

Appeal No. 2005-0473
Application No. 09/514,946

Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street, N.W.
Suite 800
Washington, DC 20005